UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,425	05/22/2001	Srinivas Bharadwaj	MEDIAFARM.PT1	9411

24490   7590   06/23/2010
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EXAMINER
COULTER, KENNETH R

ART UNIT	PAPER NUMBER
2454	

MAIL DATE	DELIVERY MODE
06/23/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/863,425	BHARADWAJ, SRINIVAS
	Examiner	Art Unit	
	Kenneth R. Coulter	2454	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>2/13/10 (RCE filed)</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,2,5-10,12,16,18-22,24,30 and 32-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,2,5-10,12,16,18-22,24,30 and 32-36</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30 and 32 – 36 are rejected under 35 USC 101 because the claimed invention, in light of the specification (for example on page 4 (paragraph 2)), encompasses non-statutory subject matter since such reads on (encompasses) software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (new EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). Even though drafted as "A method", each of the recited elements encompass their software or program per se' equivalent (i.e., a client such as a Netscape Web Browser and/or a server such as Apache are each software devices and yet phrased as a client and a server); thus, the whole of the method encompasses pure software or program per se'; unlike "A method executing on **hardware**". Also, while a hardware device claim, with functional acts, may inherently encompass a corresponding method, the same does not hold in the reverse since a corresponding method is broader in scope and can encompass a scope void of any hardware.

A claim drawn to a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory

embodiments to avoid a rejection under 35 USC 101 by **adding the limitation "non-transitory**" to the claim, yielding a **non-transitory computer readable medium**.

Claim Rejections - 35 USC § 102

1.　　　The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.　　　Claims 1, 2, 5 – 10, 12, 16, 18 – 22, 24, 30, 32 – 36 are rejected under 35 U.S.C. 102(e) as being disclosed by Kikinis (U.S. Pat. No. 6,076,109) (Simplified File Hyper-Text Protocol).

2.1　　Regarding claim 16, Kikinis discloses an apparatus comprising: a client computer configured to fit in a person's hand, comprising:

　　　　a central processor unit (Fig. 2, item 25; col. 5, lines 34 – 44 "CPU");

　　　　memory device coupled to the central processor unit, said memory being configured to store instructions to direct the central processing unit (Fig. 2, item 27; col. 5, lines 34 – 44 "memory 27");

a communication device coupled to the central processor unit and adapted to establish a wireless communication link with one or more remotely located application execution servers ("server farm") (Fig. 2, item 17; col. 5, lines 34 – 44 "modem 17");

second component coupled to the memory device, said second component configured to receive a compound request message from the server wherein the compound request message comprises a plurality of events generated in a predetermined time period (Fig. 2, item 29; col. 5, lines 34 – 44 "Video circuitry 29");

third component coupled to the memory device, said third component configured to use the compound request message to update a display state of the client computer (Fig. 2, item 29; col. 5, lines 34 – 44 "Video circuitry 29"); and a display device coupled to the central processor unit (Fig. 2, item 33)

wherein said client computer device is adapted to act as a remote output device for a client-side application programs running on said server farm over a mobile network thereby obviating the need for a browser on the client computer (col. 7, lines 24 – 31 "Proxy-Server then uses this specific information to translate HTML and other files from the Internet to a form readily usable **without extensive additional processing** by the hand-held unit."; col. 12, lines 14 – 20 (see below); col. 15, lines 9 – 31 (see below);Fig. 2, item 43; col. 6, lines 48 – 59 "NanoBrowser 43"; col. 7, lines 11 – 20; col. 8, lines 33 – 40 "NanoBrowser").

col. 12, lines 14 – 20

An **advantage inherent in different embodiments of the present invention is that future improvements in HTML, specific WEB browsing applications, and helper applications need not be installed on the**

> field units used in practicing the invention. Such improvements need
> only be made in the Proxy-Server. The Proxy-Server can also be updated
> to do the best translation possible for such improvements.

col. 15, lines 9 – 31

> At step 811 the control routines of the enhanced server begin to create
> the **best fit** in multimedia content for the requested data **according to
> the user's device capabilities and characteristics.** This process
> includes step 820 wherein the system of the invention determines if a
> best fit is immediately available. If so, control goes on to step 812.
> If not, in a preferred embodiment a best fit is generated and stored at
> step 821, and then control passes on the step 812. In step 821 a
> graphic is created having the size and resolution of the requesting
> user's display, and that picture is stored for future use. If the same
> user or a user having a device with the same display characteristics
> later requests this picture, it may be retrieved and sent immediately
> without the need for generating the best fit.

> At step 812 a single file is composed using the requested information
> processed according to the best multimedia fit for the user's device.
> That file is then transmitted to the user at step 813. Just as
> described above for other embodiments of the present invention **the file
> transmitted to the user is attuned exactly to the user's needs, and may
> be directly displayed without heavy software overhead at the user's
> device,** thereby enabling the user to maintain a **minimally-configured**
> and powered device.

2.2   Regarding claim 18, Kikinis discloses the apparatus as in claim 16, wherein the

at least one client-side application program is an E-mail client program, a streaming

media application, a browser program, a groupware program, a financial application

program, a calendar application program, or a location based service application

program (Fig. 6; col. 13, lines 37 – 67).

2.3   Per claim 19, Kikinis teaches the apparatus as in claim 16, further comprising: a

portion of the memory device configured as a local cache (Figs. 2, 4, item 107; col. 2,

lines 54 – 59 "caching functions"; col. 12, lines 14 – 20; col. 15, lines 9 – 31); wherein

drawables corresponding to the one or more application programs are stored in the

cache for local retrieval and display (Figs. 2, 4, item 107; col. 2, lines 54 – 59; col. 12,

lines 14 – 20; col. 15, lines 9 – 31).

2.4   Regarding claim 20, Kikinis discloses the apparatus as in claim 16, further

comprising: fourth component coupled to the communication device, said fourth

component configured to transmit a user's identification information to a server (Fig. 2;

Fig. 3, item 61; col. 9 lines 55 – 65); and fifth component coupled to the communication

device, said fifth component configured to receive information regarding a list of

applications previously executing for that user (Fig. 2; col. 12, lines 14 – 20; col. 15,

lines 9 – 31).

2.5   Per claim 21, Kikinis teaches the apparatus as in claim 16, further comprising:

sixth component coupled to the communication device, said sixth component configured

to select one of a plurality of applications from a list of available applications (Fig. 2; col.

12, lines 14 – 20; col. 15, lines 9 – 31).

2.6   Regarding claim 22, Kikinis teaches multimedia displaying circuitry (col. 7 lines 5

– 10 "audio and video").

2.7   Regarding claim 24, Kikinis discloses the apparatus as in claim 16, further

comprising: first component coupled to the memory device, said first component configured to transmit a list of cached drawables for an active application to a server (Figs. 2, 4, item 107; col. 2, lines 54 – 59 "caching functions"; col. 12, lines 14 – 20; col. 15, lines 9 – 31).

2.8   Per claims 30 and 32 – 36, the rejection of claims 16, 18 – 22, and 24 under 35 USC 102(e) (paragraph 2.1 – 2.7) applies fully.

2.9   Regarding claims 1, 2, 5 – 10, and 12, the rejection of claims 16, 18 – 22, and 24 under 35 USC 102(e) (paragraph 2.1 – 2.7) applies fully.

Response to Arguments

Applicant's arguments filed 2/13/10 have been fully considered but they are not persuasive.

All arguments are addressed in previous/new citations in the 35 USC 102(e) rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2454

/KRC/